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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/850,353 05/02/97 KIM

Y PC9563JTJ

EXAMINER

HM12/0305

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PATENT DEPARTMENT  
EASTERN POINT ROAD  
GROTON CT 06340

WHITE, E  
ART UNIT

PAPER NUMBER

1623  
DATE MAILED:

03/05/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/850,353

Applicant(s)  
KIM

Examiner  
Everett White

Group Art Unit  
1623



☒ Responsive to communication(s) filed on Feb 7, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-3 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-3 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. The request filed on February 7, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/850,353 is acceptable and a CPA has been established. An action on the CPA follows.
2. The request for reconsideration filed February 17, 2001 has been received and entered into the record.
3. Claims 1-3 are pending in the case.
4. All 35 U.S.C. statutes not cited in this Office action can be found cited in full in a previous Office action.

#### **35 U.S.C. 112, Second Paragraph Rejection**

5. Claims 1 and 2 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons already of record on page 2 of the Office action mailed June 17, 1999
6. Applicant's arguments filed February 7, 2001 have been fully considered but they are not persuasive. Applicant continues to argue against this rejection on the grounds that the term "desired target solubility" is completely clear and distinct when analyzed in light of the specification and the prior art. However, this argument is not persuasive since the metes and bounds of the term "desired target solubility" cannot be determined without further indication in the claims as to the particular solubility that is desired by the Applicant. Furthermore, this terminology does not fulfill the requirement of 35 U.S.C. 112, second paragraph, since this language does not point out and distinctly claim the subject matter and the specification does not provide a standard for ascertaining the requisite degree of the term. Accordingly, the rejection of Claims 1 and 2 under 35 U.S.C. 112, second paragraph is maintained.

#### **35 U.S.C. 103 Rejection**

7. Claims 1-3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant et al. (US Patent No. 5,624,940) for the reasons already of record on pages 2 and 3 of the Office action mailed June 17, 1999..

8. Applicant's arguments filed February 7, 2001 have been fully considered but they are not persuasive. Applicants argument on pages 5-8 of their response filed February 7, 2001 is not persuasive since the metes and bounds of Applicants desired target solubility cannot be determined. The claims do not specify any particular salt of a compound and only indicate that the salts of the compound are being made soluble by combining the salts of the compound with cyclodextrin, which is well known in the art as indicated in the Bryant et al patent. The fact that Applicants are determining the solubility of a series of salts (which values have not been specifically set forth in the claims) does not make the claims patentable over the prior art. Accordingly, the rejection of the claims under 35 U.S.C. 103(a) as being unpatentable over the Bryant et al patent is maintained.

9. **Summary:** All the pending claims of record (claims 1-3) are rejected.

#### **Office Action Made Final**

10. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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Art Unit: 1623

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Examiner's Telephone Number, Fax Number, and Other Information**

11. For 24 hour access to patent application information 7 days per week, or for filing applications electronically, please visit our website at [www.uspto.gov](http://www.uspto.gov) and click on the button "Patent Electronic Business Center" for more information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist, can be reached on (703) 308-1701. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

*E. White*  
White

February 28, 2001



GARY GEIST  
SUPERVISORY PATENT EXAMINER  
TECH CENTER 1600